

Appl. No. 09/764,164
Response dated April 29, 2004
Office Action dated Jan. 29, 2004

Docket No. 034300-123

REMARKS

Upon entry of this Amendment, which amends Claims 1, 19, 26 and 34, Claims 1-7 and 9-42 remain pending in the present application.

In the January 29, 2004 Office Action, Claims 1, 7-11, 19, 23, 26, 28, 31 and 34 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,360,281 to Feagans. Claims 2-6, 12-18, 20-22, 24, 25, 27, 29, 30, 32, 33 and 35-42 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Feagans in view of either alleged admitted prior art or by what the Examiner asserts are obvious modifications to the claims.

Applicant respectfully requests reconsideration of the claims in view of the above amendments and the comments below.

35 U.S.C. § 103(a) Claim Rejections – Independent Claims 1, 19, 26 and 34

In the January 29, 2004 Office Action all four of the pending independent claims, i.e. Claim 1, 19, 26 and 34, were rejected as allegedly being obvious over Feagans. For the following reasons Applicant respectfully disagrees.

Feagans discloses a system and method of obtaining diagnostic information associated with the operation of a conventional wireline modem (i.e. a modem that is coupled, via wires, between a computer station and the telephone lines). As explained in the “Background of the Invention” section of Feagans, a problem with the conventional modem was that its diagnostic capabilities required entering a “command mode” to

Appl. No. 09/764,164
Response dated April 29, 2004
Office Action dated Jan. 29, 2004

Docket No. 034300-123

retrieve diagnostic information concerning the wireline modem. To overcome this problem, Feagans proposes a system and method for communicating with a serial wireline communications device using "virtual ports". As explained in the Feagans patent, the virtual ports are accessed to provide a communications port, or to provide a command/status port for accessing status and performance information about the communications device.

By contrast, the presently claimed invention is directed at a multi-function interface device (Claims 1, 19, 34), or a wireless communication device (Claim 26), which include first and second logical devices (Claim 1), or, alternatively, a communication and status ports (Claims 19, 26, 34). In independent Claim 1, in particular, the "first logic device" is recited to have "both Internet Protocol (IP)-based and non-IP-based communication capabilities between the wireless modem and the host". Similarly, the "communication port" in independent Claims 19 and 26 is recited to be "capable of transmitting both Internet Protocol (IP)-based and non-IP-based data between the wireless communication device and the computing device". Similarly, again, the "communication port" is recited to be "configured to transmit either Internet Protocol (IP)-based or non-IP-based data between the wireless NIC and the host computer".

A review of Feagans reveals that Feagans does not teach or suggest that any of its virtual ports are capable of transmitting both IP-based and non-IP-based data. Indeed, a given virtual port in Feagans is only capable of transmitting non-IP-based data (e.g. data

Appl. No. 09/764,164
Response dated April 29, 2004
Office Action dated Jan. 29, 2004

Docket No. 034300-123

associated with a dial-up connection). Accordingly, for at least these first reasons, the § 103(a) rejections of independent Claims 1, 19, 26 and 34 cannot be properly maintained.

Second, as Applicant pointed out in the previous Amendment & Response to Office Action, dated November 5, 2003, there is no teaching or suggestion of a wireless modem or an interface for a wireless modem in Feagans. Despite acknowledging this distinction between Feagans and the presently claimed invention, in the Office Action it is asserted that “wireless modems are well known in the art, and that [t]hese types of limitations are considered field of use, and are not patentably distinct. Applicant respectfully disagrees with this mode of rejection for the following reasons.

It is undisputable that to properly set forth a *prima facie* case of obviousness, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” Here, however, there is no teaching or suggestion in Feagans that it may be combined or modified to disclose an interface or an interface for a wireless modem having the characteristics set forth in the claims of the present application. The Examiner actually acknowledges this fact in paragraph 3 (page 2) of the Office Action, where the Examiner states that “Feagans does not teach a wireless modem.”

Further, whereas wireless modems may be well known in the art, such a simple recognition alone is insufficient to provide a suggestion or motivation to modify Feagans. The Examiner must provide some suggestion or motivation to modify Feagans. Here, the

Appl. No. 09/764,164
Response dated April 29, 2004
Office Action dated Jan. 29, 2004

Docket No. 034300-123

Examiner has not done so. Accordingly, the Examiner has failed to set forth a *prima facie* case obviousness. Accordingly, for at least these second reasons, the § 103(a) rejections of independent Claims 1, 19, 26 and 34 cannot be properly maintained.

Third, Applicant respectfully believes that Feagans is non-analogous art. As stated in Section 2141.01(a): “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.”” (quoting *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The subject of wireline modems disclosed in Feagans is not in the same field of endeavor as the wireless modems claimed in the present invention. Also, the problem of overcoming the entering the command mode” in Feagans is not pertinent to the problems addressed in the present invention, e.g., one of which is monitoring the status information of a wireless modem as the wireless modem is transmitting.

For at least the foregoing reasons, Applicant respectfully believes that the § 103(a) rejections of independent Claims 1, 19, 26 and 34, as allegedly being unpatentable over Feagans, cannot be properly maintained. Applicant requests, therefore, that the § 103 rejections of independent Claims 1, 19, 26 and 34 be withdrawn.

35 U.S.C. § 103(a) Claim Rejections – Independent Claims 1, 19, 26 and 34

The remaining claims, also rejected for allegedly being obvious over Feagans, all depend from one of independent Claims 1, 19, 26 or 34. Accordingly, they derive

Appl. No. 09/764,164
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Office Action dated Jan. 29, 2004

Docket No. 034300-123

patentability as depending on what appear to be allowable base claims. Applicant requests, therefore, that the § 103(a) rejections of the dependent claims also be withdrawn.

Appl. No. 09/764,164
Response dated April 29, 2004
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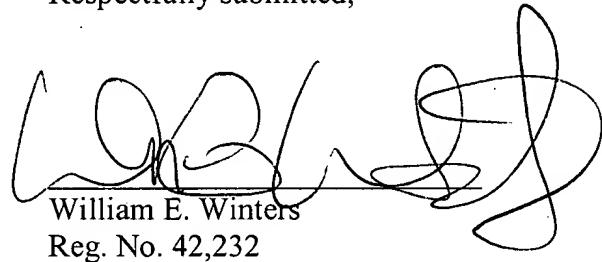
Docket No. 034300-123

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-282-1857.

Respectfully submitted,



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